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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,153	02/26/2002	Ronald W. Reynolds	REYN-25,923	2655
25883	7590	12/21/2004	EXAMINER	
HOWISON & ARNOTT, L.L.P. P.O. BOX 741715 DALLAS, TX 75374-1715			JIMENEZ, MARC QUEMUEL	
			ART UNIT	PAPER NUMBER
			3726	

DATE MAILED: 12/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/086,153

Applicant(s)

REYNOLDS, RONALD W.

Examiner

Marc Jimenez

Art Unit

3726

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 and 52-75 is/are pending in the application.
- 4a) Of the above claim(s) 20,22-48,60,62,74 and 75 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19,21,49,50,52-59,61 and 63-73 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Claims 20, 22-48, 60, 62, 74, and 75 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 3/25/04. It is noted that claims 74 and 75 are actually withdrawn because they depend upon claim 36 which is withdrawn.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claim 6** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 recites "said weld ring" in line 1 which lacks proper antecedent basis.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 3726

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1-19, 21, 49, 50, 52-59, 61, and 63-73** are rejected under 35 U.S.C. 102(b) as being anticipated by Brugman (4,062,098).

Brugman teaches a low-mass roller, comprising: a cylindrical body **4** having an exterior surface, first and second open ends and defining an interior tubular space (see where the surface where the axle **3** contacts **4**.) along a longitudinal axis therethrough for receiving an axle therein **3**, the hollow body **4** formed of polymeric material (col. 4, lines 18-19), the cylindrical body having a diameter at the first and second ends (see in the vicinity of lead line **8** in figure 1) that is smaller than a diameter thereof at at least one location (see in the vicinity of lead line **1** in figure 1) along the longitudinal axis thereof; and an outer shell **1,5** formed of metal (col. 4, line 18) proximately and conformally covering the exterior surface of and having a formed circular opening (in the vicinity of lead line **5'**) surrounding each first and second ends of the cylindrical body **4**, wherein the cylindrical body **4**, the outer shell **1,5** and the circular openings are concentric with the longitudinal axis. The area where the cylindrical body **4** contacts the axle **3** is considered an "open end" which surrounds the axle **3**. Similar to how the circular "opening" of the shell **1,5** "surrounds" each first and second ends of the cylindrical body **4**. Regarding the limitation "said outer shell disposed about said cylindrical body after formation of said cylindrical body", the patentability of product does not depend on its method of production. *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985) (citing *In re Pilkington*, 411 F.2d 1345, 1348, 162 USPQ 145, 147 (CCPA 1969)). If a product in a product-by-process claim is the same as or obvious from a product in the prior art, the claim is unpatentable even though

Art Unit: 3726

the prior product is made by a different process. *Id.* citing *In re Marosi*, 710 F.2d 799, 803, 218 USPQ 289, 292-93 (Fed. Cir. 1983); *Johnson & Johnson v. W.L. Gore*, 436 F. Supp. 704, 726, 195 USPQ 487, 506 (D. Del. 1977); see also *In re Fessmann*, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974).

Regarding claims 2, 10, and 14, note the first **1** and second **5** (note that there are two elements **5** for each end of the roll) thin-walled tubular shells having inside diameters, at first respective ends thereof, equal within a predetermined tolerance wherein the first respective ends are joined together and welded **15**. The patentability of product does not depend on its method of production. *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985) (citing *In re Pilkington*, 411 F.2d 1345, 1348, 162 USPQ 145, 147 (CCPA 1969)). If a product in a product-by-process claim is the same as or obvious from a product in the prior art, the claim is unpatentable even though the prior product is made by a different process. *Id.* citing *In re Marosi*, 710 F.2d 799, 803, 218 USPQ 289, 292-93 (Fed. Cir. 1983); *Johnson & Johnson v. W.L. Gore*, 436 F. Supp. 704, 726, 195 USPQ 487, 506 (D. Del. 1977); see also *In re Fessmann*, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974).

Regarding claims 3, 4, 52, and 70-71, note the lips **5,5'** and openings defined at the ends.

Regarding claim 49, note that each of the first and second tubular shell **5''** (figure 2) includes a respective second end opposite the first respective end such that an inward-extending lip **5,5'** formed in each of the second respective end of the first and second tubular shells **5''** defines a circular alignment opening (to receive **7**). Regarding the limitation "said outer shell disposed about said cylindrical body after formation of said cylindrical body", the patentability of product does not depend on its method of production. *In re Thorpe*, 777 F.2d 695, 697, 227

Art Unit: 3726

USPQ 964, 966 (Fed. Cir. 1985) (citing *In re Pilkington*, 411 F.2d 1345, 1348, 162 USPQ 145, 147 (CCPA 1969)). If a product in a product-by-process claim is the same as or obvious from a product in the prior art, the claim is unpatentable even though the prior product is made by a different process. *Id.* citing *In re Marosi*, 710 F.2d 799, 803, 218 USPQ 289, 292-93 (Fed. Cir. 1983); *Johnson & Johnson v. W.L. Gore*, 436 F. Supp. 704, 726, 195 USPQ 487, 506 (D. Del. 1977); see also *In re Fessmann*, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974).

Regarding claims 5, 8, 11, 12, 15, 16, 49, 50, 55, 65, and 73 note the weld ring 6 having an outside diameter smaller than the inside diameters of each respective end of the first and second thin-walled tubular shells 1,5.

Regarding claims 6, 7, 9, 13, 17, 56, and 57, note the circular band and circumferential ring 6'',6,6' made of the same materials as the shells 1,5.

Regarding claim 63, note that the inner diameter of a central portion (see in the vicinity of lead line 1 in figure 1) is greater than the inner diameter at the distal ends (see in the vicinity of lead line 8 in figure 1). Regarding the limitation "said outer shell disposed about said cylindrical body after formation of said cylindrical body", the patentability of product does not depend on its method of production. *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985) (citing *In re Pilkington*, 411 F.2d 1345, 1348, 162 USPQ 145, 147 (CCPA 1969)). If a product in a product-by-process claim is the same as or obvious from a product in the prior art, the claim is unpatentable even though the prior product is made by a different process. *Id.* citing *In re Marosi*, 710 F.2d 799, 803, 218 USPQ 289, 292-93 (Fed. Cir. 1983); *Johnson & Johnson v. W.L. Gore*, 436 F. Supp. 704, 726, 195 USPQ 487, 506 (D. Del. 1977); see also *In re Fessmann*, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974).

Regarding claims 18, 53, 58, 63, 64, and 72 note the crowned outline near the vicinity of lead line 2.

Regarding claims 19 and 59, the thickness of the hollow cylindrical body 4 is thicker than the outer shell 1,5.

Regarding claims 21 and 61, the polymeric material 4 is electrically conductive.

Regarding claims 65-66, note the support structure 4 with a bore for receiving 3 and the tubular shell 1,5 has a thickness the same from first to second ends.

Response to Arguments

6. Applicant's arguments filed 11/30/04 have been fully considered but they are not persuasive.

7. The 35 U.S.C. 112 2nd paragraph rejection to claim 6 is maintained since "said weld ring" in line 1 lacks proper antecedent basis.

8. Applicant argues that Brugman does not teach a central portion that is larger than the end portions. However, in figure 1 of Brugman, the central portion (see in the vicinity of lead line 1) is clearly larger than the end portions (see in the vicinity of lead line 8). The end portions are bound by the elements 5" which have a smaller inner diameter than the element 1.

9. Applicant argues that Brugman does not teach the "lips" as claimed. However, in figure 2, the elements labeled 5,5' are considered lips which are disposed around the circular edge of the continuous body 4.

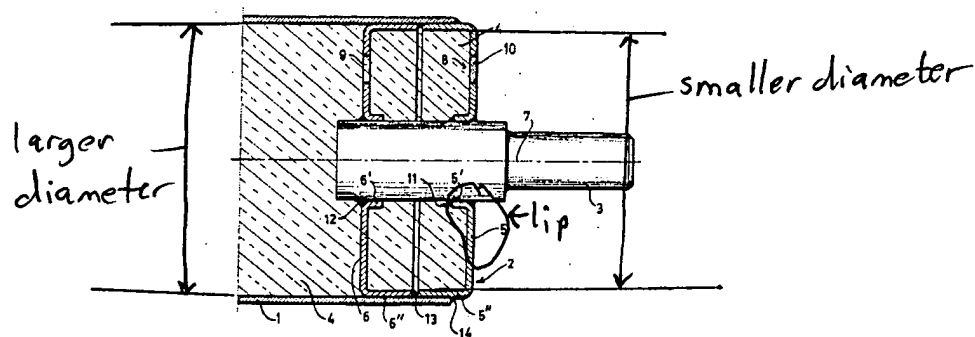
10. In response to applicant's argument that the continuous body is formed prior to the formation of the first and second tubular shells and the first and second tubular shells are

Art Unit: 3726

assembled about the continuous body after formation of the continuous body, the patentability of product does not depend on its method of production. *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985) (citing *In re Pilkington*, 411 F.2d 1345, 1348, 162 USPQ 145, 147 (CCPA 1969)). If a product in a product-by-process claim is the same as or obvious from a product in the prior art, the claim is unpatentable even though the prior product is made by a different process. *Id.* citing *In re Marosi*, 710 F.2d 799, 803, 218 USPQ 289, 292-93 (Fed. Cir. 1983); *Johnson & Johnson v. W.L. Gore*, 436 F. Supp. 704, 726, 195 USPQ 487, 506 (D. Del. 1977); see also *In re Fessmann*, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974).

11. Applicant argues that Brugman does not teach that the tubular shells do not conformally cover the cylindrical body wherein the diameter of the outermost peripheral edges is smaller than the central portion. It is noted that the shells 5 of Brugman are considered to “conformally cover” the cylindrical body 4. In figure 1 of Brugman, the central portion (see in the vicinity of lead line 1) is clearly larger than the end portions (see in the vicinity of lead line 8). The end portions are bound by the elements 5” which have a smaller inner diameter than the element 1.

12. The figure below taken from Brugman show the various elements that are considered to meet the claimed invention.



Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Interviews After Final


14. Applicant note that an interview after a final rejection will not be granted unless the intended purpose and content of the interview is presented briefly, in writing (the agenda of the interview must be in writing) to clarify issues for appeal requiring only nominal further consideration. Interviews merely to restate arguments of record or to discuss new limitations will be denied. See MPEP 714.13 and 713.09.

Contact Information

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Jimenez whose telephone number (571) 272-4530. The examiner can normally be reached on Monday-Friday between 5:30 a.m.-2:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 273-4530. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Marc Jimenez
Primary Examiner
Art Unit 3726

MJ
December 17, 2004